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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*Dep/HSS/Comm*  
#21  
AUG 24 1984  
IW

In re Application of

Applicant: JEAN-YVES CHENARD ET AL : Group 153

Serial No.: 254,313 : Examiner:

V. Hoke

Filed: April 15, 1981

**RECEIVED**

For: IMPROVEMENT IN THE STABILIZATION  
OF VINYL HALIDE POLYMERS

AUG 14 1984

**GROUP 150**

PETITION TO THE COMMISSIONER UNDER 37 CFR 1.181

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This is a petition from the requirement of the Examiner in the ex parte prosecution of the above-identified application that Applicants substantially copy the claims of U.S. Patent No. 4,360,619 for purposes of interference; this requirement on the part of the Examiner is not subject to appeal to the Board of Appeals or the Court.

THE ISSUE FOR REVIEW

The sole issue presented by this petition is the propriety of the Examiner's requirement in the Office Action of June 14, 1984 (paper No. 20) that Applicants amend their application by the inclusion of claims 1 through 21, which claims are substantially copied from U.S. Patent 4,360,619 in order to provoke an interference with said U.S. Patent.

DISCUSSION

The facts involved are as follows:

On April 11, 1983, in paper No. 10, the Examiner required Applicants to copy claims from Kugele et al, U.S. Patent 4,360,619 which issued November 23, 1982, for purposes of interference.

On July 8, 1983, Applicants requested reconsideration of the requirement that they copy the claims of U.S. Patent 4,360,619, arguing inter alia that they did not have support in their specification for the various limitations contained in the claims of this issued patent.

On September 28, 1983, in paper No. 15, the Examiner withdrew the requirement that Applicants copy the claims of U.S. Patent 4,360,619, stating (page 5):

"Since Applicants organotin halides do not overlap with Kugeles, no interference based upon the overlapping concept of an organotin halide's presence can be instituted". (sic)

On June 14, 1984, in paper No. 20, the Examiner suggested claims 1 through 21 for purposes of interference with U.S. Patent 4,360,619. These claims are substantially similar to the claims of 4,360,619, although they differ in a variety of ways.

The Examiner's requirement is contrary to the requirement of 35 USC 135(b) and 1101.02(f) MPEP, which is derived therefrom. A claim which is the same as, or for the same or substantially the same subject matter as, a

claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted. An Applicant is permitted to copy a patent claim outside the year period if he has been claiming substantially the same subject matter within the year limit. Not only have Applicants not been claiming substantially the same subject matter, but on September 28, 1983 (paper No. 15) the Examiner agreed that Applicants were not claiming substantially the same subject matter; further, the Examiner agreed that Applicants could not claim the same subject matter stating:

"Since Applicants organotin halides do not overlap with Kugeles, no interference based upon the overlapping concept of an organotin halide's presence can be instituted".

Applicants considered the Examiners comments on September 28, 1983 to be dispositive of the matter; the Examiner had required Applicants to copy claims; Applicants requested reconsideration, arguing that their specification did not contain language that would support claims as formulated in the issued patent; the Examiner agreed and withdrew the requirement. The present requirement is a total surprise, to say the least.

On November 23, 1983 the one-year period specified in 35 USC 135(b) expired and the door closed with respect to Applicants' ability to copy the claims of U.S. Patent 4,360,619 unless Applicants had been claiming substantially the same subject matter. But as of September 28, 1983 the record clearly indicates that the Applicants as well as the Examiner were in agreement that Applicants

were not claiming substantially the same subject matter (see paper No. 15).

In addition to the foregoing, Applicants continue to be of the opinion that their application does not have support (in the sense of 35 USC 112) for the various limitations and definitions in the claims proposed by the Examiner. It is emphasized that the Examiner was previously of the same opinion, stating that Applicants organotin halides do not overlap with Kugeles. One test of whether Applicants can support the claims proposed by the Examiner is whether an independent claim based on parts A and B of claim 1 as formulated by the Examiner (pages 1 to 4 of paper No. 20) would find support under 35 USC 112. Applicants respectfully submit that a claim such as is defined by elements A and B of the Examiner's proposed claim 1 would not be acceptable under 35 USC 112.

The claims proposed by the Examiner are significantly different from the claims of U.S. Patent 4,360,619. Thus, claim 1 as proposed by the Examiner omits the quantity limitations in component A, the organotin compound, and component B, the mercaptan. Thus, claim 1 of U.S. Patent 4,360,619 calls for "about 40% to about 90%" of the organotin compound and calls for "about 10% to about 60%" of the mercaptan. As indicated, these limitations have been omitted in the Examiner's formulation of a claim for interference purposes. As has been previously argued by Applicants (see the Amendment filed by Applicants on July 8, 1983), these limitations must be considered to be material and there is no basis for excluding these limitations. Further, MPEP 1101.02 states that it should be carefully noted in an interference between an Applicant

and a patentee the count must be either the patent claim or a broader claim; it cannot be a narrower claim. The claim formulated by the Examiner for purposes of interference is substantially narrower than claim 1 of U.S. Patent 4,360,619.

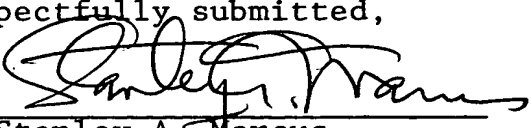
The present application and the application which matured into U.S. Patent 4,360,619 were pending before the same Examiner at the same time. The Examiner's sense of overlap between the two cases could have been dealt with in an interference between the two patent applications. The Examiner now seeks to rectify the situation by forcing Applicants to copy the claims of the issued patent, thereby burdening them with all of the disadvantages attendant to such practice. The Examiner's attempts to rectify a previous mistake, to which Applicants were not party, have served only to significantly disadvantage Applicants. A full year has now been added to the pendency of this application in connection with the Examiner's efforts to create an interference.

It is respectfully submitted that the Examiner's position requiring Applicants to copy claims from U.S. Patent 4,360,619 is contrary to statute, is contrary to established procedure and is not supported by the facts in this case. The Examiner's requirement that Applicants copy claims 1 to 21 for purposes of interference should be withdrawn.

Granting of the foregoing petition is respectfully requested.

Respectfully submitted,

By

  
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July 3, 1984  
Date